

REMARKS

Claims 19-35, 38 and 39 are in the application after amendment herein. Claims 38 and 39 are newly added. In the outstanding office action all of the claims were rejected under Section 112 first paragraph and under Section 112 second paragraph. Further, all of the claims were rejected under Section 103. Applicants request reconsideration in view of the above amendments and the following remarks. In responding to the rejections applicants first address the impropriety of the art rejections and then provide reasons why the rejections under Section 112 should now be withdrawn.

All of the art rejections of claims 19-35 rely on the Bouchard reference (WO 2003/006710) as the primary reference in combination with one or more other references: DE 41 11 174, Lashmore (5,158,653), Takeuchi (6,024,861) and GB 1521130. However, applicants submit that the Bouchard reference is not prior art because the international application designating the United States was not published in the English language. See MPEP 2136 at page 2100-91. Applicants submit that none of the prior art alone or in combination teaches or suggests any of the claimed subject matter and removal of the art rejections is required.

Applicants have amended the claims to fully address all rejections under Section 112 paragraph 1. As for the rejections under Section 112 paragraph 2, the applicants respectfully disagree with the Examiner's suggestion that the disclosure is not enabling and the implication that claim 19 might not be enabling. It appears that a first basis for the contention is that applicants have not described every detail of the well-known and basis process of electrochemical deposition. Specifically, the office action makes note that certain well-known connections are not described, such as connection of a substrate to an electrode.

First, it is submitted that the specification is enabling for the subject matter because anyone skilled in the art will understand that a complete circuit is necessary in order to conduct current to effect the deposition. If the Examiner disagrees with this, the applicants are prepared to provide the Examiner with suitable citations from numerous text books describing this basic process. As for the Examiner's reference to claim 19, as not expressly reciting an electrode in contact with an electrolyte, there is no requirement under the patent laws that every feature of the

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method claim be recited. Claim 19 as amended fully satisfies all requirements under Section 112. Further, the subject matter which the Examiner appears to find lacking is presented in claim 20 which depends from claim 19.

For these reasons, it is suggested that there is no basis for rejecting any of the claims for any lack of enablement. Removal of the rejection is requested.


Conclusion

Based on the above amendments and the foregoing remarks, the claims satisfy all requirements under Section 112 and define patentable subject matter. Accordingly, allowance of the application is requested. No additional fees are required. Nonetheless, the Commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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